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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,430	04/02/2001	Luther Jackson	GE-07043	8163
28581	7590	04/07/2006		
DUANE MORRIS LLP PO BOX 5203 PRINCETON, NJ 08543-5203			EXAMINER MEINECKE DIAZ, SUSANNA M	
			ART UNIT 3623	PAPER NUMBER
DATE MAILED: 04/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/824,430

**Applicant(s)**

JACKSON ET AL.

**Examiner**

Susanna M. Diaz

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 19, 2006 has been entered.

Claims 2-4 have been cancelled.

Claims 5-15 have been added and are presented for examination.

2. The previously pending rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph is withdrawn in response to Applicant's claim amendments.

### ***Response to Arguments***

3. No arguments have been presented by Applicant.

### ***Claim Objections***

4. Claim 15 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 5-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statutory requirement of 35 U.S.C. § 101, a claimed invention must produce a useful, concrete, and tangible result. For a claim to be useful, it must yield a result that is specific, substantial, and credible (MPEP § 2107). A concrete result is one that is substantially repeatable, i.e., it produces substantially the same result over and over again (*In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)). In order to be tangible, a claimed invention must set forth a practical application that generates a real-world result, i.e., the claim must be more than a mere abstraction (*Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77). (Please refer to the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" for further explanation of the statutory requirement of 35 U.S.C. § 101.)

While the claimed invention produces a useful and concrete result, there is no real-world or tangible effect of the invention recited; therefore, claims 5-15 are deemed to be non-statutory for failure to produce a tangible result. For example, the selecting steps may be limited to the mind of a human user, without any physical manifestation of a real-world effect.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites that the generation of the change document includes at least a rough solution to the perceived problem. The metes and bounds of a “rough” solution are unclear. How is a rough solution distinguished from a final solution, for example? Who makes such a judgment?

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (as disclosed in the “Background of the Invention” on pages 1-5 of the specification).

Applicant's admitted prior art discloses a method for determining an integrated logistic support (ILS) date at which a particular ship upgrade can proceed, said method comprising the steps of:

[Claim 5] generating a change document in response to a perceived problem associated with a particular type of equipment (Page 1, lines 9-12; Page 4, lines 12-26);

associating said change document with those ships having said particular type of equipment (Page 4, line 23 through Page 5, line 4 -- The Background of the Invention acknowledges that, while this is a difficult task, it needs to be, i.e., has been already been, performed);

associating the particular ship upgrade with the change document for that particular ship upgrade (Page 4, lines 12-15);

determining arrival dates of all elements associated with the particular upgrade associated with the change document (Page 3, lines 9-19);

[Claim 6] obtaining a promised delivery date for delivering an upgrade parts kit (Page 3, lines 9-19);

[Claim 8] wherein said step of generating a change document includes the step of generating a change document including at least a rough solution to said perceived problem (Page 4, lines 12-15 -- An upgrade of equipment implies that an improvement is being made to the equipment. Motivation for upgrading equipment may be seen as part of a perceived problem. The changes in the equipment that result from the upgrade may be seen as a "rough solution to said perceived problem");

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[Claim 9] wherein said step of generating a change document includes the step of generating a change document identifying the system which is impacted (Page 4, lines 12-15 – The specific equipment being upgraded serves as a system or part of one);

[Claim 10] wherein said step of associating said change document with those ships having said particular type of equipment includes the step of determining whether a particular class of ship is affected (Page 4, lines 1-15 – There has to be a basic understanding of the characteristics of maintained ships, which broadly define “classes” of ships, in order to know how to upgrade a particular ship, which spare parts are needed, etc.);

[Claim 12] wherein said step of determining arrival dates of all elements associated with the particular upgrade associated with the change document includes the steps of:

determining *at least one of* if (a) a Tailored Repairable Items List is required, (b) training is required to implement the alteration of the ship, (c) an Allowance Parts List is required, (d) technical manuals are required, (e) Preventive Maintenance Schedule and Maintenance Requirement Cards are required, (f) a shipyard Installation and Checkout Spares List is required, (g) an Alteration Installation and Checkout Spares List is required, (h) a Coordinated Shore Base Material Allowance List is required, (i) Support and Test Equipment is required, (j) Maintenance Assist Modules are required, (k) On-Board Allowance is required, and (l) alteration instructions are required (Page 4, lines 1-15 – It is determined which technical manuals need to be changed in response to equipment upgrades, thereby addressing at least (d) and (l));

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[Claim 13] wherein said step of determining arrival dates of all elements associated with the particular upgrade associated with the change document includes the steps of:

determining whether alteration parts kits are required (Page 3, lines 9-19); and  
if alteration parts kits are required, determining the promised delivery date for those not yet arrived (Page 3, lines 9-19).

Regarding claims 5, 6, and 15, while Applicant's admitted prior art does not expressly state that the ILS date for a selected ship upgrade is set as the promised date (i.e., arrival date) which is most remote in time, Applicant's admitted prior art does essentially state that an upgrade cannot be officially completed until all upgrade requirements are met (i.e., all parts required for upgrade are received, all technical manuals are updated, etc.):

... At some point in the accumulation process, lifetime support and depot operations collaborate on the status of critical logistical elements, which indicate what particular components of the necessary alteration kit or kits have been delivered, but as to undelivered materials, has only a manufacturer's promised delivery date upon which to rely. The scheduling of the upgrade is, of course, based upon the promised delivery dates. If these dates are not met, the materials cannot be shipped to the upgrade site so as to arrive in time for the scheduled starting date. the materials do not arrive on the manufacturer's promised date, then, the upgrade cannot begin, and the upgrade site, as for example a dry-dock, has a ship sitting therein on which work cannot be started, at least as to the missing alteration kits. Such late-arriving alteration kits can be stored until a later scheduled upgrade time, possibly years in the future, but cannot be installed during this particular scheduled upgrade interval...



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Each ship upgrade requires upgrading of the technical manuals associated with the upgraded equipment so that the upgraded equipment may be properly maintained. If the technical manual is classified, it must be treated differently than spare parts. Documentation must be provided for the handling of the technical manuals, and their arrival in time for the upgrade must be considered. (Page 3, lines 9-32; Page 4, lines 12-20)

Since Applicant's admitted prior art acknowledges that an upgrade cannot be officially completed until all upgrade requirements are met (i.e., all parts required for upgrade arrive, all technical manuals are updated, etc.) and that scheduling is typically based on the promised delivery dates of materials required to perform the upgrade, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to perform with the prior art method of selecting a ship upgrade, selecting that one of said promised dates which is most remote in time and deemed said one of said promised dates (i.e., arrival dates) to be said ILS date (which inherently includes comparing the ILS date with the selected date) in order to help ensure that the ILS date is reasonably set at a time when all upgrade requirements will have been met (i.e., all parts required for upgrade will have arrived, all technical manuals will have been updated, etc.). Similarly (regarding claims 6 and 15), the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to compare the promised delivery date with the selected date in order to further ensure that all upgrade parts will be delivered on time.

(Please note that the Examiner understands that Applicant's intended invention is meant to address an improved method for determining "the status of accumulation of

the necessary equipments for an upgrade of a major asset" (page 5, lines 10-13 of the specification); however, the details of such an improved method have not been clearly expressed in the claimed invention.)

[Claim 7] Applicant's admitted prior art does not expressly teach who performs the step of generating a change document; however, Official Notice is taken that it is old and well-known in the art of product document management to allow changes to the document to be made by engineering personnel. Since engineering personnel are often the most knowledgeable regarding the technical changes to a product that would affect related manuals, allowing the engineering personnel to directly make these changes would more efficiently yield more accurate manual updates when changes are made to a product. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Applicant's admitted prior art such that the step of generating a change document is performed by engineering personnel since engineering personnel are often the most knowledgeable regarding the technical changes to a product that would affect related manuals. By allowing the engineering personnel to directly make the type of document changes disclosed by Applicant's admitted prior art, such a process would more efficiently yield more accurate manual updates when changes are made to a product.

[Claim 11] While Applicant's admitted prior art teaches the step of associating the particular ship upgrade with the change document for that particular ship upgrade (Page 4, lines 1-15), it does not expressly teach that said step of associating includes the step

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of assignment of an alteration number representing a particular alteration of a particular ship. However, Official Notice is taken that it is old and well-known in the art of product upgrades and corresponding manual updates to assign an alteration number representing a particular alteration of the product. For example, different version numbers may be assigned to a product and its corresponding manual as the product goes through various releases incorporating upgrades. Use of such alteration numbers provides more clear documentation of the features possessed by each version of a product. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Applicant's admitted prior art such that the step of associating the particular ship upgrade with the change document for that particular ship upgrade includes the step of assigning an alteration number representing a particular alteration of a particular ship in order to provide more clear documentation of the features possessed by each version of a product, which is often helpful in managing product and company profiles.


[Claim 14] Claim 14 recites limitations already addressed by the rejection of claims 5 and 6 above; therefore, the same rejection applies.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

April 2, 2006